

### REMARKS

This is a full and timely response to the final Official Action mailed May 2, 2005. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 1, 6-10, 13-17, 20 and 21 have been cancelled. Various other claims have been amended to account for the cancellation of these claims. No new subject matter is introduced or new issues raised. Consequently, claims 2-5, 11, 12, 18, 19 and 22-31 are currently pending for further action.

#### Prior Art -- § 102:

In the final Action is a rejection of claims 1-21 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,579,446 to Naik et al. ("Naik"). For at least the following reasons, this rejection is respectfully traversed.

Claim 2 recites:

- A printer driver stored on a computer-readable medium comprising:
  - an interface configured to receive print job data;
  - a print job formatting routine which notes one or more regions within a print job derived from said print job data and further specifies a particular print quality level at which each such region is then printed;
  - a WYSIWYG display routine for generating a WYSIWYG display of said print job; and
  - a user input routine for receiving user input defining said one or more regions within said print job using said WYSIWYG display.

Independent claim 11 similarly recites:

- A method of printing documents comprising printing designated regions within a print job at different print quality levels, said method further comprising:
  - displaying a WYSIWYG display of said print job; and
  - receiving user input defining one or more of said regions within said print job using said WYSIWYG display.

Independent claim 18 recites:

A computer system comprising:  
a host computer;  
an interface on said host computer for connecting a printing device to said host computer; and  
a printer driver stored on said host computer for formatting print job data from said host computer to a printing device;  
wherein said printer driver comprises a print job formatting routine which notes one or more regions within a print job derived from print job data and further specifies a particular print quality level at which each such region is to be printed; and  
~~The system of claim 15,~~ wherein said print driver further comprises:  
a WYSIWYG display routine for generating a WYSIWYG display of a print job; and  
a user input routine for receiving user input defining said one or more regions within a print job using said WYSIWYG display.

In contrast, Naik does not teach or suggest a user input routine or method step for receiving user input defining one or more regions within a print job. Naik at Fig. 5, for example, teaches that text, graphics and photos are recognized by the system and may be printed using different techniques. Naik implies that these elements are automatically recognized by the system and then printed accordingly. (Naik, col. 5, lines 26-29). Naik never teaches or suggests that a user input routine receives user input that defines one or more regions within a print job.

The recent final Office Action refers to Naik at Figs. 2 and 3 as allegedly showing “that a user may define text, graphics and photo regions of a document.” (Action of 5/2/05, p. 10, sec. 7). This is incorrect. These figures show different elements, such as text and graphics, that are combined into a document. But, the cited figures do not teach or suggest that a user does or is able to define a region within the print job. Fig. 5 further makes clear that the user is merely adjusting settings for pre-defined classes of objects, such as text, graphics and photos. The user has no option to define what a region is or what a region contains as in Applicant’s claims.

This is significant because the Naik system will treat all graphics alike, all text alike and all photos alike. In contrast, the system described and claimed by the Applicant allows a user to define any regions the user desires. Consequently, two photographs can be designated as different regions and treated differently. A region can be defined to include both text and a photo or graphic. These features are not possible with the Naik system and highlight the fact that Naik does not teach or suggest the claimed "user input routine" through which user input defines the regions within a print job that are printed at different quality levels.

Additionally, Naik does not teach or suggest the claimed WYSIWYG display. As defined in Applicant's specification, "WYSIWYG stands for What You See Is What You Get. The WYSIWYG illustration is intended to show the user precisely what the print job will look like when printed. If the print job contains multiple pages, the WYSIWYG illustration driven by the routine (204) will preferably allow the user to move between pages of the print job within the WYSIWYG display. While viewing the WYSIWYG display, or any page thereof, the user can define particular regions on the print job using the WYSIWYG display. The user can then specify separate and independent print quality settings for those defined regions." (Applicant's specification, paragraphs 0042-0043).

Thus, a WYSIWYG display, as claimed, is not merely a representation of the document to be printed, as shown in Naik's Fig. 2A, but is a representation of precisely what the print job will look like when printed. Naik does not describe Fig. 2A as representing a WYSIWYG display. Naik does not anywhere teach or suggest a WYSIWYG display as claimed.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed.

Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, for at least this reason, the rejection of claims 2, 11 and 18 and their respective dependent claims based on Naik should be reconsidered and withdrawn.

Claim 5 recites:

The printer driver of claim 4, wherein said user input routine is configured to display movement of a cursor on said WYSIWYG display in response to physical movement of said mouse, said movement of said cursor being used by said user input routine to define said one or more regions within said print job. (emphasis added).

Claim 12 similarly recites: “The method of claim 11, further comprising specifying said one or more regions within said print job by moving a cursor driven by a mouse over said WYSIWYG display.”

In contrast, Naik does not teach or suggest a mouse operating a cursor where the movement of the cursor defines one or more regions within a print job that are treated differently as claimed. *The final Office Action fails to indicate how or where this subject matter is taught or suggested by the prior art of record.* For at least this additional reason, the rejection of claim 5 should be reconsidered and withdrawn.

Prior Art -- § 103:

Claims 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Naik and U.S. Patent No. 6,107,113 to Nicoloff Jr., et al. (“Nicoloff”). This rejection is respectfully traversed for at least the same reasons given above with respect to the independent claims from which claims 22-24 respectively depend.

Claims 25-27 and 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Naik and Kamasak (of record). For at least the following reasons, this rejection is respectfully traversed.

Claim 25 recites:

A printer driver stored on a computer-readable medium comprising:  
an interface configured to receive print job data;  
a user interface with which a user designates one or more specific regions of a print job represented by said print job data; and  
a print job formatting routine which notes said one or more regions within said print job and further specifies a particular print quality level at which each such region is then printed.

In making this rejection, the final Office Action states that “Naik teaches a user interface with which a user designates one or more specific regions.” (Action of 5/2/05, p. 8). As demonstrated above, this is incorrect. Naik does not ever teach or suggest that a user designates specific regions. Rather, the various elements of a print job are automatically identified to the user and printing techniques to be used on those regions are then selected. (Naik, col. 5, lines 26-33). The user of the Naik system does not designate specific regions of the print job.

Similarly, Kamasak does not teach or suggest a user interface in which a user designates one or more specific regions of a print job. Rather, Kamasak merely states that the described system “[s]egments the document into regions that require different print modes.” (Kamasak, p. 4). Kamasak does not ever teach or suggest that this segmentation is based on user input through a user interface that designates specific regions.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580

(CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least this reason, the rejection of claim 25 and its dependent claims should be reconsidered and withdrawn.

Moreover, Applicant notes that Kamasak is not valid prior art as against the present application. Kamasak was published sometime between Sept. 30, 2001 and October 5, 2001. The present application was filed contemporaneously on October 11, 2001. However, the Applicant invented the present subject matter well prior to the publication date of the Kamasak reference and then diligently pursued the filing of the present application.

The undersigned hereby declares under 37 C.F.R. § 1.132 that documents in the possession of the undersigned show that Applicant fully described and enabled the subject matter now claimed in the present application prior the publication of the Kamasak reference. Consequently, the Kamasak reference is not valid prior art as against the present application. For at least this additional reason, the rejection of claim 25 and its dependent claims should be reconsidered and withdrawn.

Claim 28 was rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Naik, Kamasak and Nicoloff. This rejection is respectfully traversed for at least the same reasons given above with respect to claim 25, from which claim 28 depends.

Conclusion:

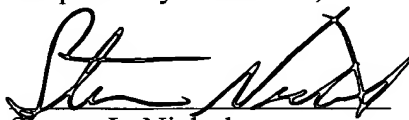
Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The amendment does not introduce new subject matter or raise new issues requiring further search or consideration. Several formerly dependent claims are rewritten as independent claims, herein, including all the recitations of their former respective

base claims. Other amendments are merely to account for the cancellation of formerly independent claims.

This amendment clearly places the application in better form for allowance or appeal by reducing the number of claims and the issues presented. Moreover, Application feels that the present amendment clearly places the application in condition for allowance. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols  
Registration No. 40,326

DATE: 28 June 2005

Steven L. Nichols, Esq.  
Managing Partner, Utah Office  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095

(801) 572-8066  
(801) 572-7666 (fax)

**CERTIFICATE OF MAILING**DATE OF DEPOSIT: June 28, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.



Brian J. Riddle